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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,163	10/15/2001	Wolfgang Schrof	49512	4283

26474 7590 08/28/2003

KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER
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LAZOR, MICHELLE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/28/2003

60

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/977,163

Applicant(s)

SCHROF ET AL.

Examiner

Michelle A Lazor

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10, 11 and 13-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 11, 13, 14 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Neff (U.S. Patent No. 5609687).

Regarding Claim 10, Neff discloses a means of producing at least one coating film on at least one area of a substrate surface, having: one storage container or reservoir (2); one exposure unit or laser (18); and one application unit having a nozzle (8), wherein said exposure unit is designed so that radiation generated in said exposure unit is brought into contact with one coating formulation in said application unit (Figure 1; column 2, lines 10 – 21). Although not specifically disclosed by Neff, the apparatus is considered capable of using a reactive coating formulation in the extruder. Thus Neff discloses all of the limitations of Claim 10 and anticipates the claimed invention.

Regarding Claim 11, Neff discloses a waveguide which brings the radiation into contact with said at least one reactive coating formulation in said at least one application unit (column 3, lines 18 – 30). Thus Neff discloses all of the limitations of Claim 11 and anticipates the claimed invention.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Neff as disclosed in Claim 10 above, in view of Keyworth et al. (U.S. Patent No. 5723176).

Neff discloses all of the limitations of Claim 10, but does not specifically disclose a UV exposure unit or more specifically a UV laser. However, Keyworth et al. suggests using a UV exposure unit (38) or an ultraviolet laser (column 1, line 57 – column 2, line 11). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a UV exposure unit or an ultraviolet laser since it is a well known source of energy in the art, which can be easily controlled (column 2, lines 5 – 8).

***Allowable Subject Matter***

5. Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. There was no reference in the prior art search that disclosed, taught, or suggested the application unit to be a spraying head. Whitney et al. (U.S. Patent No. 5043548) disclose a spraying unit wherein an exposure unit is designed so that energy generated in the exposure unit is brought into contact with a coating formulation in the application unit. However, there is no suggestion to use a radiation-curable reactive coating

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formulation. Therefore Whitney et al. do not anticipate the claimed invention. Dispensing means, as disclosed by Neff (Figure 1), are predominantly what were found in the prior art search which are used as an application unit as claimed.

### ***Response to Arguments***

Regarding the rejection of Claim 10 under 35 USC § 112, second paragraph, Examiner agrees with the Applicant and withdraws the rejection.

Regarding the rejection of Claims 10 and 11 under 35 USC § 102(b) as anticipated by Neff, Examiner disagrees with the Applicant. Although Neff discloses a bead of material on a substrate, the apparatus is capable of using a lower viscosity coating material which would produce a coating film over a substrate. In any event, a bead as disclosed by Neff can be placed on a substrate as a strip and thereby act as a coating film as claimed. Also, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a UV exposure unit or a UV laser) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 10 only claims an exposure unit, which Neff discloses as discussed above.

Regarding the rejection of Claims 10 and 15 under 35 USC § 102(b) as anticipated by Whitney, Examiner agrees with the Applicant and withdraws the rejection.

Regarding the rejection of Claims 13 and 14 under 35 USC § 103(a) as being unpatentable over Neff in view of Keyworth et al., Examiner disagrees with the Applicant. One

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of ordinary skill in the art would know to use a UV exposure unit, an ultraviolet laser, or electromagnetic energy from a laser, since they are all well known sources of energy in the art.

### *Conclusion*

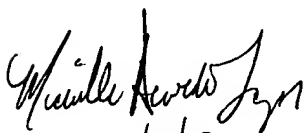
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

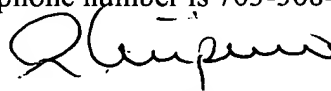
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 703-305-7976. The examiner can normally be reached on Mon - Thurs 6:30 - 4:00, Fridays 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
8/12/03

  
RICHARD CRISPINO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700